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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/788,902	02/26/2004	Christopher W. Blackburn	1842.022US1	4532

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LEUNG, JENNIFER	
ART UNIT	**PAPER NUMBER**
3714	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/788,902	BLACKBURN ET AL.	
	Examiner	Art Unit	
	Jennifer Leung	3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *12 March 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-31* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-31* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *12 March 2007* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *3/12/2007*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

This Office action is in response to the Remarks filed on 3/12/2007. Claims 1-31 are pending.

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 13-17 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 13-17 of copending Application No. 10/788,661 in view of Gatto (US 6,916,247). Both sets of claims are similar except for the service. According to Gatto (col. 15, lines 54-56), any type of web services can be offered. Therefore, substituting gaming management service for a game update service is obvious.

This is a provisional obviousness-type double patenting rejection.

3. Claims 1-11, 13-17, and 20-30 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1, 2, 5, 6, 8-10, 13-16, 20-24, 28, 29, 32, 33, 35-37, and 40-43 of copending Application No. 10/789,957 in view of Gatto (US 6,916,247). Both sets of claims are similar except for the service. According to Gatto (col. 15, lines 54-56), any type of web services can be offered. Therefore, substituting progressive service for a game update service is obvious.

This is a provisional obviousness-type double patenting rejection.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 1-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gatto (US 6,916,247) in view of Rowe (US 6,645,077).

Re claim 1: Gatto discloses a method for providing a service in a gaming network (col. 15, lines 20-30), the method comprising: publishing the availability of the service on the gaming network (Fig. 19; col. 13, lines 64-67); receiving a request

to register with the service from a gaming machine (Fig. 20); and processing one or more service requests between the gaming machine and the service (Fig. 19; col. 15, lines 45-49; col. 15, lines 57-60; col. 16, lines 7-11; col. 18, lines 4-6).

However, Gatto fails to disclose a game update service. Rowe discloses such (Fig. 8).

Therefore, in view of Rowe, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include the aforementioned limitation in order to provide updates to the game software in a timely manner and only parts of the software need be replaced, not for example, an entire disk (col. 11, lines 47-65 of Rowe).

Re claim 2: Gatto, as modified by Rowe, discloses wherein the game update service comprises a web service (col. 15, lines 49-56).

Re claims 3, 11, 15, 22, and 30: Gatto, as modified by Rowe, teaches wherein the service request comprises a request for notification of a game content update (col. 11, lines 39-45 of Rowe: in order for the player/gaming machine to initiate a download, it must be notified that there are game updates available) by the gaming machine (Fig. 20; col. 5, lines 1-2; col. 14, lines 10-32 of Gatto).

Re claim 4: Gatto, as modified by Rowe, teaches further comprising: receiving a game content change (col. 17, lines 10-12; col. 19, lines 55-58 of Gatto); and issuing a notification of the game content update to the gaming machine in

response to the game content change (Fig. 20; col. 5, lines 1-2; col. 14, lines 10-32 of Gatto) (col. 11, lines 39-45 of Rowe: in order for the player/gaming machine to initiate a download, it must be notified that there are game updates available).

Re claim 5: Gatto, as modified by Rowe, teaches wherein the service request comprises a request to download game content to the gaming machine (col. 11, lines 39-45 of Rowe) (col. 15, lines 20-30 of Gatto).

Re claim 6: Gatto, as modified by Rowe, discloses wherein the service request is initiated by the gaming machine (col. 16, lines 1-3; col. 20, lines 32-37; col. 16, lines 7-11: if the gaming machine can function as either the service requestor or provider, then the request can be initiated by the gaming machine).

Re claim 7: Gatto, as modified by Rowe, discloses wherein the service request is initiated by the game update service (col. 16, lines 1-3; col. 20, lines 32-37; col. 16, lines 7-11: if the service can function as either the service requestor or provider, then the request can be initiated by the service; as described in the specification of the current application (10/788902), this is the PUSH method (page 17, lines 26-28). The applicant admits that this method is prior art (page 20, lines 9-11)).

Re claim 8: Gatto discloses a method for updating game content on a gaming machine via a service in a gaming network (col. 15, lines 20-30), the method

comprising: issuing a request to discover a service description for the service (col. 15, lines 60-62); receiving the service description (col. 15, lines 63-67); registering with the service (Fig. 20; col. 15, lines 62-63; col. 17, lines 22-24); and processing one or more service requests between the gaming machine and the service (Fig. 19; col. 15, lines 45-49; col. 15, lines 57-60; col. 16, lines 7-11; col. 18, lines 4-6).

However, Gatto fails to disclose a game update service. Rowe discloses such (Fig. 8).

Therefore, in view of Rowe, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include the aforementioned limitation in order to provide updates to the game software in a timely manner and only parts of the software need be replaced, not for example, an entire disk (col. 11, lines 47-65 of Rowe).

Re claim 9: Gatto, as modified by Rowe, discloses wherein the game update service comprises a web service (col. 15, lines 49-56).

Re claim 10: Gatto, as modified by Rowe, discloses wherein the service description comprises a web services description language (col. 15, lines 52-53).

Re claim 12: Gatto, as modified by Rowe, teaches further comprising: receiving a notification that game content has been updated (Fig. 20; col. 5, lines 1-2; col. 14, lines 10-32 of Gatto); and issuing a request to download the game content

(col. 15, lines 20-30 of Gatto) (col. 11, lines 39-45 of Rowe: in order for the player/gaming machine to initiate a download, it must be notified that there are game updates available).

Re claim 13: Gatto discloses a gaming network system providing a service (col. 15, lines 20-30), the gaming network system comprising: a service communicably coupled to a gaming network (Fig. 19; col. 13, lines 64-67); a discovery agent communicably coupled to the gaming network (Fig. 19; col. 15, lines 49-56; col. 15, lines 63-67; col. 16, lines 14-19); and at least one gaming machine communicably coupled to the gaming network (Fig. 1; col. 5, lines 29-32); wherein the service is operable to: publish the availability of the service to the discovery agent (Fig. 19; col. 13, lines 64-67; col. 15, lines 54-56); receive registration requests from the at least one gaming machine (Fig. 20); and process service requests between the gaming machine and the service (Fig. 19; col. 15, lines 45-49; col. 15, lines 57-60; col. 16, lines 7-11; col. 18, lines 4-6).

However, Gatto fails to disclose a game update service. Rowe discloses such (Fig. 8).

Therefore, in view of Rowe, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include the aforementioned limitation in order to provide updates to the game software in a timely manner and only parts of the software need be replaced, not for example, an entire disk (col. 11, lines 47-65 of Rowe).

Re claim 14: Gatto, as modified by Rowe, discloses wherein the game update service comprises a web service (col. 15, lines 49-56).

Re claim 16: Gatto, as modified by Rowe, teaches wherein the game update service is further operable to: receive a game content change (col. 17, lines 10-12; col. 19, lines 55-58 of Gatto); and issue a notification of the game content update to the gaming machine in response to the game content change (Fig. 20; col. 5, lines 1-2; col. 14, lines 10-32 of Gatto) (col. 11, lines 39-45 of Rowe: in order for the player/gaming machine to initiate a download, it must be notified that there are game updates available).

Re claim 17: Gatto, as modified by Rowe, teaches wherein the service request comprises a request to download game content to the gaming machine (col. 15, lines 20-30 of Gatto) (col. 11, lines 39-45 of Rowe).

Re claim 18: Gatto, as modified by Rowe, discloses wherein the service request is initiated by the gaming machine (col. 16, lines 1-3; col. 20, lines 32-37; col. 16, lines 7-11: if the gaming machine can function as either the service requestor or provider, then the request can be initiated by the gaming machine).

Re claim 19: Gatto, as modified by Rowe, discloses wherein the service request is initiated by the game update service (col. 16, lines 1-3; col. 20, lines 32-37; col. 16, lines 7-11: if the service can function as either the service requestor or

provider, then the request can be initiated by the service; as described in the specification of the current application (10/788902), this is the PUSH method (page 17, lines 26-28). The applicant admits that this method is prior art (page 20, lines 9-11)).

Re claim 20: Gatto discloses a computer-readable medium having computer executable instructions (col. 17, lines 15-18) for performing a method for providing a service in a gaming network (col. 15, lines 20-30), the method comprising: publishing the availability of the service on the gaming network (Fig. 19; col. 13, lines 64-67); receiving a request to register with the service from a gaming machine (Fig. 20); and processing one or more service requests between the gaming machine and the service (Fig. 19; col. 15, lines 45-49; col. 15, lines 57-60; col. 16, lines 7-11; col. 18, lines 4-6).

However, Gatto fails to disclose a game update service. Rowe discloses such (Fig. 8).

Therefore, in view of Rowe, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include the aforementioned limitation in order to provide updates to the game software in a timely manner and only parts of the software need be replaced, not for example, an entire disk (col. 11, lines 47-65 of Rowe).

Re claim 21: Gatto, as modified by Rowe, discloses wherein the game update service comprises a web service (col. 15, lines 49-56).

Re claim 23: Gatto, as modified by Rowe, teaches wherein the method further comprises: receiving a game content change (col. 17, lines 10-12; col. 19, lines 55-58 of Gatto); and issuing a notification of the game content update to the gaming machine in response to the game content change (Fig. 20; col. 5, lines 1-2; col. 14, lines 10-32 of Gatto) (col. 11, lines 39-45 of Rowe: in order for the player/gaming machine to initiate a download, it must be notified that there are game updates available).

Re claim 24: Gatto, as modified by Rowe, teaches wherein the service request comprises a request to download game content to the gaming machine (col. 15, lines 20-30 of Gatto) (col. 11, lines 39-45 of Rowe).

Re claim 25: Gatto, as modified by Rowe, discloses wherein the service request is initiated by the gaming machine (col. 16, lines 1-3; col. 20, lines 32-37; col. 16, lines 7-11: if the gaming machine can function as either the service requestor or provider, then the request can be initiated by the gaming machine).

Re claim 26: Gatto, as modified by Rowe, discloses wherein the service request is initiated by the game update service (col. 16, lines 1-3; col. 20, lines 32-37; col. 16, lines 7-11: if the service can function as either the service requestor or provider, then the request can be initiated by the service; as described in the specification of the current application (10/788902), this is the PUSH method

(page 17, lines 26-28). The applicant admits that this method is prior art (page 20, lines 9-11)).

Re claim 27: Gatto discloses a computer-readable medium having computer executable instructions (col. 17, lines 15-18) for performing a method for updating game content on a gaming machine via a service in a gaming network (col. 15, lines 20-30), the method comprising: issuing a request to discover a service description for the service (col. 15, lines 60-62); receiving the service description (col. 15, lines 63-67); registering with the service (Fig. 20; col. 15, lines 62-63; col. 17, lines 22-24); and processing one or more service requests between the gaming machine and the service (Fig. 19; col. 15, lines 45-49; col. 15, lines 57-60; col. 16, lines 7-11; col. 18, lines 4-6).

However, Gatto fails to disclose a game update service. Rowe discloses such (Fig. 8).

Therefore, in view of Rowe, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include the aforementioned limitation in order to provide updates to the game software in a timely manner and only parts of the software need be replaced, not for example, an entire disk (col. 11, lines 47-65 of Rowe).

Re claim 28: Gatto, as modified by Rowe, discloses wherein the game update service comprises a web service (col. 15, lines 49-56).

Re claim 29: Gatto, as modified by Rowe, discloses wherein the service description comprises a web services description language (col. 15, lines 52-53).

Re claim 31: Gatto, as modified by Rowe, teaches wherein the method further comprises: receiving a notification that game content has been updated (Fig. 20; col. 5, lines 1-2; col. 14, lines 10-32 of Gatto); and issuing a request to download the game content (col. 15, lines 20-30 of Gatto) (col. 11, lines 39-45 of Rowe: in order for the player/gaming machine to initiate a download, it must be notified that there are game updates available).

Response to Arguments

6. Applicant's arguments, see page 10, filed 3/12/2007, with respect to claims 3, 12, 15, 22, and 31 have been fully considered and are persuasive. The objection of these claims has been withdrawn.

7. Applicant's arguments, see page 10, filed 3/12/2007, with respect to Figure 3 have been fully considered and are persuasive. The objection of Figure 3 has been withdrawn.

8. Applicant's arguments, see pages 11-12, filed 3/12/2007, with respect to claims 1 and 20 have been fully considered and are persuasive. The Section 101 rejection of claims 1 and 20 has been withdrawn.

9. Applicant's arguments, see page 12, filed 3/12/2007, with respect to claim 15 have been fully considered and are persuasive. The Section 112 rejection of claim 15 has been withdrawn.

10. Applicant's arguments filed 3/12/2007 have been fully considered but they are not persuasive. On page 13 of the Remarks, Applicant argues that Gatto's process is opposite that of the processes in the claims. However, Gatto does disclose the subject matter in the Applicant's claims. While Figs. 19 and 20 of Gatto show that the "specialized device" acts as a provider and the "server" acts as a requestor, Gatto also discloses in col 16, lines 5-10, that peripherals (the "specialized device") can also be service requestors and that servers can provide services.

11. Applicant's arguments with respect to claims 1, 3-4, 8, 11-13, 15-16, 20, 22-23, 27, and 30-31 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

12. Applicant's submission of an information disclosure statement under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p) on 3/12/2007 prompted the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 609.04(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer Leung whose telephone number is 571-270-1342. The examiner can normally be reached on Mon -Thur, every other Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert E. Pezzuto can be reached on 571-272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jennifer Leung
May 14, 2007

Robert E. Pezzuto
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